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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/753,093	01/02/2001	Jonathan L. Lei	23803-250394	1317

7590 02/09/2004

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EXAMINER

LUGO, CARLOS

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 02/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/753,093

Applicant(s)

LEI, JONATHAN L.

Examiner

Carlos Lugo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 71-83 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 71-83 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### DETAILED ACTION

1. This Office Action is in response to applicant's amendment filed on November 17, 2003.

#### *Specification*

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

- The applicant in claim 74 is claiming, "the transaction logic completes the wireless transaction regardless of whether a live connection is establish between the transaction recipient, via the portable electronic device, and the transaction provided". However, there is no mention of this limitation in the specification.

#### *Claim Objections*

3. **Claim 83 is objected** to because of the following informalities:

- Line 2, change "the a container" as -the container-.

Appropriate correction is required.

#### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1-6,9-12,71-73 and 80-83 are rejected** under 35 U.S.C. 102(b) as being anticipated by Amazon.com (Amazon).

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Regarding claims 1 and 82, Amazon discloses a self-contained business transaction capsule (a software, Page 1). The capsule comprises data regarding the wireless transaction and transaction logic to complete the transaction (all the product data, prices, etc., that will appear when an user search and data regarding the checkout when the user wants to buy).

The capsule is adapted to be broadcasted to and stored on a portable electronic device (communication between the cellular phone or palm device and Amazon.com).

As to claim 2, Amazon discloses that the data regarding the wireless transaction includes at least one of a price, a transaction description and an image (Page1).

As to claims 3,4 and 12, Amazon discloses that the transaction logic includes at least one of billing and shipping information, order routing information, order status information, shipping status information and transaction rules and the transaction logic is adapted to transmit data from the portable electronic device to a transaction system (Pages 1 and 3).

As to claim 5, Amazon discloses that the completed transaction data is transmitted to the transaction system via at least one of direct dialing with a wireless telephone protocol, utilizing Short Messaging System (SMS) and via Transmission Control Protocol/Internet Protocol (using a cellular or a palm device, Page 1).

As to claim 6, Amazon discloses that the portable electronic device is a mobile wireless-enabled device (cellular or palm).

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As to claim 9, Amazon discloses that the capsule is broadcasted to the portable electronic device by at least one of a radio wave, a TV signal, a cellular telephony signal, a satellite signal and an infrared signal.

As to claims 10 and 83, Amazon discloses that the portable electronic device includes a container for storing the capsule (memory of the device).

As to claim 11, Amazon discloses that the capsule communicates to a plurality of systems (to corroborate the credit card, etc) to complete the wireless transaction.

As to claim 71, Amazon discloses that the capsule migrates onto different electronic systems, completing a portion of the transaction via each of the different electronic systems (broadcasting the capsule to different electronic devices when each user access Amazon to download the software or program).

As to claim 72, Amazon discloses that the capsule is a device-independent computer-readable file (program or software).

As to claim 73, Amazon discloses that after the wireless transaction is been completed, the capsule is transmitted to a mobile commerce system (feedback).

As to claim 80, Amazon discloses that the data regarding the wireless transaction is selected from the group consisting of informational content and a message (information received after entering a search inquire).

As to claim 81, Amazon discloses that the transaction logic includes at least one message routing logic and recipient lists.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) The invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. **Claims 1-6 and 9-12,71-73 and 80-83 are rejected** under 35 U.S.C. 102(e) as being anticipated by US Pat No 6,512,919 to Ogasawara (Ogasawara '919).

Regarding claims 1 and 82, Ogasawara '919 discloses a self-contained business transaction capsule (Col. 3 Lines 4-13). The capsule comprises data regarding the wireless transaction and transaction logic to complete the transaction (Col. 5 Lines 49-59).

The capsule is adapted to be broadcasted to and stored on a portable electronic device (when the person dials the store number).

As to claim 2, Ogasawara '919 discloses that the data regarding the wireless transaction includes at least one of a price, a transaction description and an image (Col. 14 Lines 23-28).

As to claims 3,4 and 12, Ogasawara '919 discloses that the transaction logic includes at least one of billing and shipping information, order routing information,

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order status information, shipping status information and transaction rules and the transaction logic is adapted to transmit data from the portable electronic device to a transaction system (Col. 14 Lines 23-49).

As to claim 5, Ogasawara '919 discloses that the completed transaction data is transmitted to the transaction system via at least one of direct dialing with a wireless telephone protocol, utilizing Short Messaging System (SMS) and via Transmission Control Protocol/Internet Protocol (using a cellular 18).

As to claim 6, Ogasawara '919 discloses that the portable electronic device is a mobile wireless-enabled device (cellular).

As to claim 9, Ogasawara '919 discloses that the capsule is broadcasted to the portable electronic device by at least one of a radio wave, a TV signal, a cellular telephony signal, a satellite signal and an infrared signal (Col. 5 Lines 1-9).

As to claims 10 and 83, Ogasawara '919 discloses that the portable electronic device includes a container for storing the capsule (memory of the device).

As to claim 11, Ogasawara '919 discloses that the capsule communicates to a plurality of systems (to corroborate the credit card, etc) to complete the wireless transaction.

As to claim 71, Ogasawara '919 discloses that the capsule migrates onto different electronic systems, completing a portion of the transaction via each of the different electronic systems (broadcasting the capsule to different electronic devices when each user dial the store number to download the software or program).

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As to claim 72, Ogasawara '919 discloses that the capsule is a device-independent computer-readable file (program or software).

As to claim 73, Ogasawara '919 discloses that after the wireless transaction is been completed; the capsule is transmitted to a mobile commerce system (feedback).

As to claim 80, Ogasawara '919 discloses that the data regarding the wireless transaction is selected from the group consisting of informational content and a message (information received by the user).

As to claim 81, Ogasawara '919 discloses that the transaction logic includes at least one message routing logic and recipient lists.

8. **Claims 75-78 are rejected** under 35 U.S.C. 102(e) as being anticipated by US Pat No 6,385,591 to Mankoff.

Regarding claim 75, Mankoff discloses a self-contained business transaction discount capsule (the virtual coupon downloaded) comprising data regarding the wireless transaction (Figure 3) and transaction logic to complete the transaction (transfer the virtual coupon in a retail establishment Abstract Lines 17-22).

The capsule is adapted to be broadcasted to and stored on a portable electronic device (Col. 4 Lines 5-37 and Col. 5 Lines 7-20).

As to claim 76, Mankoff discloses that the capsule includes a time stamp (the data obtained is storage in a calendar that will give the user an alert of when is going to expire the coupon and also, when the user is going to redeem the coupon, the data obtained will state the expiration date).



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As to claim 77, Mankoff discloses that the capsule is downloaded from a web server (25).

As to claim 78, Mankoff discloses that the capsule can be transferable from a first portable electronic device (laptop) to a second portable device (PDA or Palm).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claim 7 is rejected** under 35 U.S.C. 103(a) as being unpatentable over Amazon.com (Amazon) in view of Bluetooth.

Amazon fails to disclose that the portable electronic device utilizes a wireless networking protocol. Amazon discloses that any wireless portable electronic device can be used (cellular, palm, etc).

Bluetooth teaches that is known in the art to have a portable electronic device that use a Bluetooth wireless networking protocol (Pages 2 and 4).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a Bluetooth wireless networking protocol, as taught by Bluetooth, into a portable electronic device as described by Amazon, in order to have a better communication.

11. **Claim 7 is rejected** under 35 U.S.C. 103(a) as being unpatentable over US Pat No 6,512,919 to Ogasawara (Ogasawara '919) in view of Bluetooth.

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Ogasawara '919 fails to disclose that the portable electronic device utilizes a wireless networking protocol. Ogasawara '919 discloses that any wireless portable electronic device can be used (cellular, palm, etc).

Bluetooth teaches that is known in the art to have a portable electronic device that use a Bluetooth wireless networking protocol (Pages 2 and 4).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a Bluetooth wireless networking protocol, as taught by Bluetooth, into a portable electronic device as described by Ogasawara '919, in order to have a better communication.

**12. Claim 8 is rejected** under 35 U.S.C. 103(a) as being unpatentable over Amazon.com (Amazon) in view of E-Commerce Times, "Amazon and Sprint debut wireless Net Shopping (E-Commerce).

Amazon fails to disclose that the capsule is adapted to readily transmit from the portable electronic device to another portable electronic device.

E-Commerce teaches that Amazon is able to send gifts to other people using the wireless net shopping. Also, E-Commerce teaches that Sprint launches a PCS wireless web that offer many Internet tools (inside the wireless web) that includes sending or receiving emails (See Page 2).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to send a capsule (via email or other internet tool), as taught by E-Commerce, into the devices used by the people using Amazon, in order to permit other people to use the system.

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**13. Claim 8 is rejected** under 35 U.S.C. 103(a) as being unpatentable over US Pat No 6,512,919 to Ogasawara (Ogasawara '919) in view of E-Commerce Times, "Amazon and Sprint debut wireless Net Shopping (E-Commerce).

Ogasawara '919 fails to disclose that the capsule is adapted to readily transmit from the portable electronic device to another portable electronic device.

E-Commerce teaches that Sprint launches a PCS wireless web that offer many Internet tools (inside the wireless web) that includes sending or receiving emails (See Page 2).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to send a capsule (via email or other internet tool), as taught by E-Commerce, into the devices used by the people using the system described by Ogasawara '919, in order to permit other people to use the system.

**14. Claim 74 is rejected** under 35 U.S.C. 103(a) as being unpatentable over Amazon.com (Amazon) in view of US Pat No 6,535,913 to Mittal et al (Mittal).

Amazon fails to disclose that the transaction logic completes the wireless transaction regardless of whether a live connection is established between the transaction recipient, via the portable electronic device, and the transaction provided.

Mittal teaches that is known in the art the use of offline communication to facilitate the transaction between the user and the system (Col. 7 Line 39).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a transaction logic that will work regardless of whether

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a live connection is established between the transaction recipient, via the portable electronic device, and the transaction provided, as taught by Mittal, into a system as described by Amazon, in order to allow the user to order a product at any time.

**15. Claim 74 is rejected** under 35 U.S.C. 103(a) as being unpatentable over US Pat No 6,512,919 to Ogasawara (Ogasawara '919) in view of US Pat No 6,535,913 to Mittal et al (Mittal).

Ogasawara '919 fails to disclose that the transaction logic completes the wireless transaction regardless of whether a live connection is established between the transaction recipient, via the portable electronic device, and the transaction provided.

Mittal teaches that is known in the art the use of offline communication to facilitate the transaction between the user and the system (Col. 7 Line 39).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a transaction logic that will work regardless of whether a live connection is established between the transaction recipient, via the portable electronic device, and the transaction provided, as taught by Mittal, into a system as described by Ogasawara '919, in order to allow the user to order a product at any time.

**16. Claim 79 is rejected** under 35 U.S.C. 103(a) as being unpatentable over US Pat No 6,385,591 to Mankoff in view of US Pat No 6,535,913 to Mittal et al (Mittal).

Mankoff fails to disclose that the transaction logic completes the wireless transaction regardless of whether a live connection is established between the

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transaction recipient, via the portable electronic device, and the transaction provided.

Mittal teaches that is known in the art the use of offline communication to facilitate the transaction between the user and the system (Col. 7 Line 39).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a transaction logic that will work regardless of whether a live connection is established between the transaction recipient, via the portable electronic device, and the transaction provided, as taught by Mittal, into a system as described by Mankoff, in order to allow the user to order a product at any time.

### ***Response to Arguments***

17. Applicant's arguments filed November 17, 2003 have been fully considered but they are not persuasive.

Regarding applicant's arguments that Amazon fails to disclose the invention as claimed in claim 1 (Page 9 Line 13), Amazon.com Anywhere discloses the invention as claimed.

A person that will like to search and buy using his cellular phone or his PDA (Palm) needs to download software or program in order to be able to deal with Amazon. As clearly stated in point 5 of the FAQ under Amazon.com Anywhere (Page 3), a person is able to see data of the item (including pricing, available information, etc.).

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Therefore, Amazon clearly discloses "a self-contained business transaction capsule" that comprises data regarding the wireless transaction (details of the product, pricing, etc.) and transaction logic to complete the transaction (Buy Now).

As to applicant's argument that Ogasawara '919 fails to disclose the invention as claimed in claim 1 (Page 10 Line 8), Ogasawara '919 discloses the invention as claimed in claim 1.

A person that will like to by from outside the store, a wire transaction, using his cellular phone, can download "capsule" or program. The program will allow the customer to effect purchase transactions (Col. 5 Lines 49-59).

Ogasawara '919 clearly discloses "a self-contained business transaction capsule" that comprises data regarding the wireless transaction (details of the product, pricing, etc.) and transaction logic to complete the transaction (Buy Now).

As to applicant's arguments that neither Amazon nor Ogasawara '919 disclose the invention as claimed in the new claims (Page 12 Line 22), Amazon and Ogasawara '919, alone or in view of Larson or Mittal, disclose the invention as claimed (See rejection above).

### ***Conclusion***

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos Lugo whose telephone number is 703-305-9747. The examiner can normally be reached on 9-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Swann can be reached on 703-306-4115. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5771.

Carlos Lugo  
Examiner  
Art Unit 3677

February 3, 2004.

  
J. J. SWANN  
SUPERVISORY PATENT EXAMINER  
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